

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re)	Decision on	JUL 23 1999
)	Petition for Regrade	
)	Under 37 C.F.R. § 10.7(c)	
)		

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 4, 5, 7, 10, 11, 18, 22, 25, 26 and 30 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64 on the afternoon section. On December 15, 1998, Petitioner requested regrading of ten two point questions on the afternoon section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for

incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the afternoon section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner’s arguments have been considered.

Question 4 reads as follows:

4. Star Chemical Corporation retains you to obtain patent protection for their invention relating to improved production of ethylene oxide. You prepare and file a patent application in the PTO having a specification satisfying the requirements of 35 U.S.C. § 112 and the following two claims, which are fully supported by the specification:

1. A process for preparing a silver-supported catalyst for the improved production of ethylene oxide, said process comprising the steps of:

- (a) forming an aqueous solution of silver salt;
- (b) immersing completely in said solution a carrier of inert, porous particles, characterized by an average diameter not larger than 3/16 inch, an average pore diameter of 10 to 70 microns, and a surface area less than one square meter per gram;
- (c) impregnating said particles with said solution;
- (d) separating the impregnated particles from the remainder of said solution;
- (e) drying the separated particles, whereby said silver salt is deposited uniformly throughout the pores of said particles; and
- (f) activating the dried particles by heating them in air at a temperature sufficient to decompose the deposited silver salt.

2. An oxygen-activated catalyst for use in the controlled catalytic oxidation of ethylene to ethylene oxide, said catalyst comprising 5 to 25% by weight of silver, said silver being the thermal decomposition product of a pore solution-deposited silver salt uniformly distributed throughout the pores of inert, porous particles.

Claim 1 is rejected in the first Office Action under 35 U.S.C. § 103 as unpatentable over Able in view of Baker. Claim 2 is rejected under 35 U.S.C. § 103 as unpatentable over Baker. Able discloses a process for producing a catalyst for oxidation of ethylene to ethylene oxide by impregnating a porous carrier with a solution of a silver salt of an organic acid, separating the excess liquid, drying the impregnated carrier, and decomposing the silver salt by direct heat in an inert gas. Baker discloses a method of making an oxygen activated catalyst by coating a carrier with a silver catalyst using a paste or slurry. The silver compound paste is coated on the support, dried and then activated by treating the catalyst in large trays for several hours in a forced draft hot air oven at about 400°C. Baker discloses the physical characteristics of the oxygen-activated catalyst. The physical characteristics of the claimed catalyst are indistinguishable from Baker's catalyst.

Which of the following represents the best course of action to overcome the rejection and obtain a Notice of Allowance in the application?

- (A) Cancel Claim 1 and argue that the inventive catalyst has both high selectivity, i.e., a measure of the ability of a catalyst to prefer the partial oxidation reaction of ethylene over the total oxidation reaction of ethylene to carbon dioxide, and high productivity, i.e., a

measure of the amount of ethylene oxide produced per unit of catalyst and per unit of time.

- (B) Cancel Claim 2 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.
- (C) Amend Claim 1 to recite that an oxidizing agent is added to the solution to prevent premature reduction of the silver salt.
- (D) Cancel Claim 1 and amend Claim 2 to recite that the inert, porous particles contain silica-alumina, and argue that such recitation is not disclosed by the references.
- (E) Cancel Claim 1 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.

Choice (B) is the best course of action to overcome the rejection. Choice (B) overcomes the rejection of Claim 2 by cancellation and leaves only process Claim 1 which involves (i) impregnation of a carrier with a silver salt deposited from solution, and (ii) an activation step involving heating in air. While Able teaches step (i), his activation step involves heating in an inert gas, whereas Baker teaches step (ii) but his impregnation step involves impregnation of a carrier with a silver salt by coating the carrier with a paste or slurry. The argument in choice (B) is based on the facts presented because there is no suggestion in the references to arbitrarily select Able's step (i) and Baker's step (ii) and combine them to arrive at the inventive process. *In re Brown*, 459 F.2d 531, 533, 173 USPQ 685, 686 (CCPA 1972) (catalyst activation step using inert gas teaches away from combination with reference using air).

Petitioner contends that "Answer C is a better answer than B since it does not require the unnecessary cancellation of claim 2." According to Petitioner, "[a] reading of the terms that does less violence to their expected meaning would show that Able and Baker both treat the carrier as a macromolecular structure to which a past [sic] is applied

or from which excess water is removed and do not teach or suggest the focus on molecular pore deposition of the oxygen-activated catalyst invention.” Petitioner maintains that “[t]hough the physical characteristics of the catalyst may be the same in that an equal surface area of catalyst will facilitate the same number of reactions, the fact that the catalyst is mounted within the pores of each discrete particle differentiates it from the two cited references which use a carrier substrate to hold the catalyst.” Petitioner further maintains that “[t]he use of Able and Baker’s carrier substrate would require that new material be constantly pumped over the activating catalyst, a potentially more expensive and exacting environment.”

Petitioner’s arguments are not persuasive. Choice (C) is not a better strategy for overcoming the rejection because it assumes facts not presented. Specifically, choice (C) proposes an amendment not supported in the disclosure provided in violation of 35 U.S.C. §§ 132 and 112. Petitioner’s contention that “[t]here is no suggestion in either of the references teaching the limitation of particle pore deposited oxygen activated catalyst of claim 2” is contrary to the facts. The facts provided in the question state that “[t]he physical characteristics of the claimed catalyst [in Claim 2] are indistinguishable from Baker’s catalyst.” Further, choice (C) is wrong because the product-by-process claim, i.e. Claim 2, remains in the application. Since the patentability of such a claim does not depend on its method of production, and the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Brown*, 459 F.2d at 535, 173 USPQ at 688 (“[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based

alternatively on either section 102 or 103 of the statute is eminently fair and acceptable”); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself”); MPEP § 2113. Petitioner’s argument that “the fact that the catalyst is mounted within the pores of each discrete particle differentiates it from the two cited references which use a carrier substrate to hold the catalyst” is based on facts not presented in the question in violation of the Examination Directions. No error in grading has been shown. Petitioner’s request for credit on question 4 is denied.

Question 5:

Two points are awarded for question 5.

Question 7 reads as follows:

7. Inventor Jones received a patent that, through error and without deceptive intent, failed to describe an embodiment of her invention. Eighteen months after the patent was issued, you filed a complete reissue application adding a claim directed to the omitted embodiment, together with Jones’ declaration explaining the error, and the other required papers. In accordance with PTO practice and procedure,

- (A) The claim is subject to a rejection under 35 U.S.C. § 132.
- (B) The specification is subject to an objection as failing to provide proper antecedent basis for the claimed subject matter and require correction.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

Choice (C) is the most correct answer because the amendment claiming the omitted embodiment is new matter. MPEP § 1411.02.

Petitioner contends that “answer D is the best answer since it most clearly complies with the statutory directive entitling Petitioner to broadening issue within 2 years of issue and does not require the contemplation of additional facts not presented in the question.” According to Petitioner, “[t]he facts indicate Petitioner failed to disclose the alternate embodiment, but the facts of the question presented do not go so far as to state that the claim had no support in the original disclosure.” Petitioner maintains that “[t]he choice of answer C requires the assumption that the alternative embodiment lacks support in the original disclosure, a fact not presented in the fact pattern of the question.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, the facts of the question specifically state that “Inventor Jones received a patent that . . . failed to describe an embodiment of her invention.” The reissue application was filed “adding a claim directed to the omitted embodiment.” Choice (D) is incorrect because Jones did not describe the embodiment in the original patent. No error in grading has been shown.

Petitioner’s request for credit on question 7 is denied.

Question 10 reads as follows:

10. Applicant claims the following container lid combination:

1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under

35 U.S.C. 102. Which of the following replies to the rejection would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

Choice (C) is the most correct answer because amending the claim to add specific structural dimensions or other limitations is most likely to distinguish Claim 1 from prior art X. MPEP § 2114. Choice (E) is incorrect because an amendment such as proposed in choice (C) is likely to overcome the rejection and result in issuance of the claim. Choice (A) is incorrect because analogous art is not a consideration for an anticipation rejection under 35 U.S.C. § 102. See *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“the question whether a reference is analogous art is irrelevant to whether that reference anticipates”); MPEP § 2131.05. Choice (B) is incorrect because dispensing candy pieces as mentioned in Claim 1 is merely a functional description that does not structurally distinguish Claim 1 from X, which can be used to dispense liquids or solids. In *Schreiber*, claims directed to a funnel top for a popcorn dispenser were not successfully distinguished over a prior art oil funnel on the grounds that the claimed top was used for popcorn because the oil funnel inherently performs this function. *Schreiber* at 1479, 44 USPQ2d at 1433 (“declaration fails to show that [anticipating reference] inherently lacks the functionally defined limitations recited in claim”). Choice (D) is incorrect because choices (A) and (B) are incorrect.

The correct answer is choice (C) and Petitioner selected choice (E). Petitioner contends that “[t]he claims give no information as to the dimensions of the candy funnel or the prior art funnel or its dispensed solids and no specification is provided, thus without assuming facts not presented in the question, answer E is the most correct answer.” According to Petitioner, “[i]n the present case, the ratio of the size of the dispensed candies to the opening and gradient would need to be compared to the prior art ratio which is not provided for in the question.” Petitioner maintains that “[i]n the absence of a statement in the question that the structural limitations are adequately supported by the specification, the better answer makes no such assumption.” Petitioner concludes that “Answer E is therefore the better answer.”

Petitioner’s arguments are not persuasive. The question is directed to which of the replies to the 35 U.S.C. § 102 rejection “would be most likely to result in issuance of Claim 1.” Based on the facts provided in the question, amending Claim 1 to add specific limitations to the dimensions of the dispensing top is the most correct answer. MPEP § 2114 provides that “[e]ven if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.” See also *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) (claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function). Adding specific limitations to the dimensions of the dispensing top differentiates Claim 1 from prior art X in terms of structure rather than function. Choice (C) is thus the most likely of the replies to result in issuance of Claim 1. No error in grading has been shown. Petitioner’s request for credit on question 10 is denied.

Question 11 reads as follows:

11. While researching heart disease, Dr. Able developed a process for preparing compounds which exert "strongly saluretic [sodium expelling] and diuretic [water expelling] effects." Dr. Able found that these compounds were useful also in the treatment of heart conditions and hypertension. Dr. Able's compounds are substituted dihydrobenzothiadiazines having an "R" group at position 3 of the benzothiadiazine nucleus wherein R is selected from the group consisting of phenyl, benzyl, and phenethyl. You prepare a patent application on Dr. Able's invention and file the application in the PTO on August 5, 1996. The sole original claim is as follows:

A substituted dihydrobenzothiadiazine compound wherein the only variable is an "R" group at position 3 of the benzothiadiazine nucleus, said "R" group being selected from the group consisting of phenyl, benzyl, and phenethyl, and said compound exerting strong saluretic and diuretic effects and being useful in the treatment of heart conditions and hypertension.

In the first Office action, the claim is rejected under 35 U.S.C. § 102(e) as unpatentable over the Baker patent, which issued June 25, 1998 on an application filed May 13, 1996. The Baker specification states that it is "a continuation-in-part application of my application Serial No. 123,456, filed September 29, 1995 (now abandoned)." The Baker patent relates to processes for preparing compounds having a generic formula which includes within its scope substituted dihydrobenzothiadiazine compounds, and a list of appropriate substituents disclosed by the Baker patent includes the compounds of Dr. Able's claim. One of the processes disclosed by Baker in the patent and in application '456 for preparing the compounds is identical to Dr. Able's process in all material respects. The '456 application discloses several closely related processes for preparing compounds having a generic formula identical to that disclosed in the issued patent. But the '456 application contained an even broader disclosure. Comparison of the generic disclosure and the nature of the substituents on the benzothiadiazine nucleus as disclosed in the Baker patent and the '456 application reveals that they both disclose the "R" group as including hydrogen, trifluoromethyl, benzyl, or phenethyl. In rejecting Dr. Able's claim, the examiner placed emphasis on Example 2 of the '456 application, particularly, the last paragraph, which stated that other reagents may be used in the preparation process employed in Example 2, and identified specific reagents, which if used would result in each of the compounds of Dr. Able's claim, i.e., compounds wherein the "R" group was phenyl, benzyl, or phenethyl. In reply to the Office action, you file an amendment limiting the variable of Dr. Able's claim to one of

the following "R" groups. Which one is most likely to overcome the rejection?

- (A) phenyl
- (B) benzyl
- (C) phenethyl
- (D) trifluoromethyl
- (E) None of the above

The most correct answer is choice (A) because a phenyl substituent is not described in the Baker patent. The Baker patent cannot anticipate the claim to the phenyl "R" group because "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. Accordingly, the rejection under section 102(e) cannot be maintained. Choice (E) is not correct because choice (A) is likely to overcome the rejection.

Petitioner contends that "Dr. Able's claims to medically active dihydrobenzothiadiazine compounds Are [sic] independent of Baker's claims to processes of preparing the compounds and the limiting of the variable to the phenyl of answer A is incorrect." According to Petitioner, "the PTO has decided that Baker's process is not obvious since it issued a patent to it while the parent application ineffective as a 102(e) does indicate that the process can be used to make other and different substituted products." Petitioner maintains that "any showing by Able as to material differences in the process used to create the diuretic and saluretic compounds would provide an alternative independent basis for finding these independent inventions for the purposes of restriction practice which is a higher bar than we need in [sic] these circumstances."

Petitioner's arguments are not persuasive. The question is directed to which one of the four "R" groups, if any, is most likely to overcome the rejection under 35 U.S.C. § 102(e). Petitioner's position that "the PTO has decided that Baker's process is not obvious" is not relevant to the question presented. The disclosure of "phenyl" as an "R" group in Baker's compounds occurs only in the abandoned patent application, i.e., the '456 application, referenced in the Baker patent. Since the '456 application became available as prior art only as of the date that the public gained access to the Baker patent, i.e., June 25, 1998, the '456 application is not available as a reference against Able's claims because the Baker patent was granted after Dr. Able's filing date. *In re Lund*, 153 USPQ 625, 633 (CCPA 1967) (material in abandoned parent that was not carried over into CIP is not described in patent issued on the CIP and is not available under section 102(e)); MPEP § 2127(a). Petitioner's arguments relating to Baker's claims are not germane. No error in grading has been shown. Petitioner's request for credit on question 11 is denied.

Question 18 reads as follows:

18. The claims of an application limit a scanning device as having a specific angular view. A patent issues. One year after the patent issued, the patentee filed a reissue application with all required papers. As filed, the claims in the reissue application are amended to remove the limitations directed to the specific angular view. Which of the following is correct?

- (A) The patentee may not broaden his claims through reissue by removing the limitations directed to the specific angular view.
- (B) Since the patentee is removing a limitation, the claim is being narrowed.
- (C) The patent may not be modified after issuance.
- (D) The patentee may broaden claims through reissue by removing the limitation directed to the specific angular view.
- (E) The Patent and Trademark Office may not allow broader claims during reissue.

The most correct answer is choice (D) and Petitioner selected choice (E). Choice (D) is correct because 35 U.S.C. § 251 permits the broadening of claims if sought within two years from the grant of the original patent.

Petitioner contends that “Answer E is a better answer since it admits Petitioner may broaden the claims but reminds us that the Office may decide that the broadened claims lack support in the original disclosure.” According to Petitioner, “[t]he fact pattern of the question does not disclose whether the broadened claim is supported by the specification.” Petitioner maintains that “answer D does not encompass the additional facet of the rule that the broadened claim must be supported by the disclosure.”

Petitioner’s arguments are not persuasive. Choice (D) is a correct statement of the law. Choice (E) applies only to those situations where broadened claims lack support in the original disclosure. However, the facts presented in this case do not indicate any such lack of support. Thus, Choice (E) is not the most correct answer because it assumes a lack of support for the claims, contrary to the Examination direction that states “Do not assume any additional facts not presented in the questions.” No error in grading has been shown. Petitioner’s request for credit on question 18 is denied.

Question 22 reads as follows:

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.

- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.
- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because the claims in each of choices (A) – (C) are in proper format.

Petitioner selected choice (C). Petitioner contends that “Claim C is not in proper format since it calls for a device which lacks interconnection between each element in the structure.” Petitioner points out that the claim recites “wherein the side walls are joined to the front and rear walls.” According to Petitioner, “[t]he claim lacks a similar joinder of the side-front-rear wall assembly to the bottom and must therefore be rejected as an improper claim under MPEP 2173.05(k) discussing the aggregation.” Petitioner further maintains that “[a]nswer C is therefore a better answer than answer E since answer E assumes that the bottom structure is linked to the side-front-rear wall assembly without any support for such assumption in the claim language.”

Petitioner’s arguments are not persuasive. Petitioner’s interpretation that the claim in choice (C) “lacks a similar joinder of the side-front-rear wall assembly to the bottom” fails to establish that choice (C) is not in proper format because there is no basis for requiring “similar joinder.” MPEP § 2173.05(k) does not support Petitioner’s contention because the MPEP states that an aggregation rejection may be entered only if specific

findings have been made. More specifically, the MPEP instructs that “it is improper to reject claims as ‘aggregative’ without specifying the statutory basis for the rejection, i.e., an applicant is entitled to know whether his claims are being rejected under 35 U.S.C. 101, 103, or 112.” See MPEP § 2173.05(k), citing *In re Gustafson*, 331 F.2d 905, 141 USPQ 585 (CCPA 1964). In the present case, there are no facts presented in the question that support a rejection under any of the statutes. Thus, Petitioner’s argument lacks any foundation. There is no basis for Petitioner’s further contention that “answer E assumes that the bottom structure is linked to the side-front-rear wall assembly without any support for such assumption in the claim language.” No error in grading has been shown. Petitioner’s request for credit on question 22 is denied.

Question 25 reads as follows:

25. Which of the following is false?

- (A) The meaning of terms in a claim should be ascertainable by reference to the description in the specification.
- (B) While a term used in a claim may be given a special meaning in the description, no term may be given a meaning repugnant to the usual meaning of the term.
- (C) Trademarks may be used in claims only if each letter in the trademark is capitalized.
- (D) Claims may not contain tables or chemical or mathematical formulas.
- (E) Figures may be incorporated by reference in the claims.

Choices (C) and (D) are false statements and are, therefore, correct answers.

Choice (C) is a false statement because capitalization alone is not enough to constitute proper use of a trademark in a claim. Trademarks should be identified by capitalizing each letter of the mark. See MPEP § 608.01(v). However, as discussed in MPEP § 2173.05(u), a claim should be carefully analyzed to determine how a trademark is used

in the claim. “If the trademark . . . is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph.” *Id.* citing *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). In such a case, the claim scope is uncertain since a trademark is a source identifier, not an identification of a particular material or product. “If a trademark . . . appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed.” MPEP § 2173.05(u). Thus, it is not true that trademarks may be used in the claim **only if** each letter in the trademark is capitalized. Choice (D) is a false statement because claims may contain chemical or mathematical formulas and, if necessary, may contain tables. See 37 CFR § 1.58(a).

Petitioner selected choice (A). Petitioner contends that choice (A) “essentially stands for the proposition that an applicant must disclose everything in the specification from ‘first principles.’” Petitioner argues that this is a false proposition because applicants do not have to define terms that are well known to those of skill in the art. Petitioner contends this proposition is inconsistent with MPEP § 2173.05(a), which states that term meanings “should be apparent from the prior art **or** from the specification and drawings at the time the application is filed.” (Petitioner’s emphasis). According to Petitioner, “[t]he question as presented is not so specific and asks more generally whether each and every term in the claim must be ascertainable by reference to the description in the specification.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, choice (A) does not stand “for the proposition that an applicant must disclose everything in the specification from ‘first principles.’” Choice (A) is a true statement because “the

terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR § 1.75(d)(1); See also MPEP § 608.01(o) (“The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; . . .”). No error in grading has been shown. Petitioner’s request for credit on question 25 is denied.

Question 26 reads as follows:

26. The claim below is incomplete because it is missing limitation (iii).

A seating device comprising:

- (i) a base member having four parallel edges, and opposing first and second sides;
- (ii) a back member connected to one of the edges of the base member forming a right angle with said first side;
- (iii) _____
- (iv) a pair of arm members connected to said back member and said first and second leg members, wherein said arm members are capable of supporting the arms of a person sitting in the seating device.

Of the following choices, which would be the best to complete the claim by providing the missing limitation (iii)?

- (A) a set of leg members connected to the second side of said base member;
- (B) a first pair of leg members connected to the second side of said base member at the same edge as the back member, and a second pair of leg members connected to the opposite edge of said support member;
- (C) first, second, third, and fourth leg members connected to said underside of said base member;
- (D) first, second, third, and fourth leg members connected to said second side of said base member, each edge having a leg member adjacent to said edge, wherein said leg members are parallel to each other;
- (E) first, second, third, and fourth leg members connected to said corners of said second side of said base member;

The most correct answer is choice (D) and Petitioner selected choice (E). Choice (D) would be best to complete the claim because it provides antecedent basis for “said first and second leg members” referred to in limitation (iv). 35 U.S.C. § 112, second paragraph; MPEP § 2173.05(e). Choice (E) would not complete the claim because it introduces the new limitation “said corners” that lacks antecedent basis.

Petitioner contends that “[c]hoosing limitation E is a better answer since it does not create any inconsistencies with existing limitations and apprises Examiner as to the correct enabling placement of the legs.” According to Petitioner, “[t]he lack of antecedent basis for said corners might be overcome by pointing out that the parallelogram defined by the 4 edges would necessarily have 4 corners on each side and such limitation is inherent in the structure described.”

Petitioner’s arguments are not persuasive. Choice (E) is not the best choice because it introduces a new problem -- there is no antecedent basis for choice (E)’s recitation “said corners.” Petitioner recognizes that choice (E) creates an antecedent basis problem. However, Petitioner’s argument that choice (E)’s antecedent basis problem might be solved by reliance on an inherency argument does not show that choice (E) is a better choice than choice (D). Choice (D) is the best choice because it provides the necessary antecedent basis for “said first and second leg members” without introducing another problem. No error in grading has been shown. Petitioner’s request for credit on question 26 is denied.

Question 30 reads as follows:

30. Which of the following requirements of 35 U.S.C. § 112 do NOT apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

Choice (E) is correct. 35 U.S.C. § 171 provides “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided.”

Petitioner contends that choice (D) is the most correct answer. According to Petitioner, “[d]esign patents can only have one claim, the requirement that the single claim be independent provides no narrowing over this single claim requirement.”

Petitioner’s arguments are not persuasive. The third paragraph of section 112 states that “[a] claim may be written in independent, **or if the nature of the case admits**, in dependent . . . form.” (Emphasis added). The nature of design patents does not admit claims in dependent form because Rule 1.153(a) prohibits more than one claim in design patents where it states “[m]ore than one claim is neither required nor permitted.” Thus, the statutory requirement for at least one independent claim controls design patents. The rule operates within the authority of the statute and merely prohibits more than the statutorily required independent claim. Petitioner’s argument that section 112, third paragraph provides “no narrowing” of the one claim rule is wrong because it inverts the authorities by making the rule dominate the statute. A rule cannot “otherwise provide” because a rule provided in the Code of Federal Regulations has no authority to override a

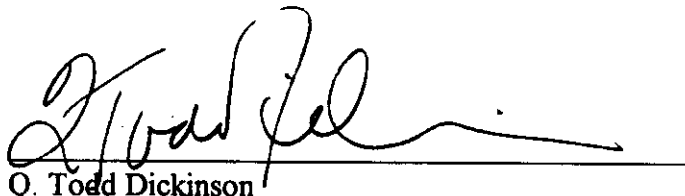
statute. No error in grading has been shown. Petitioner's request for credit on question 30 is denied.

ORDER

For the reasons given above, two points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 66. This score is insufficient to pass the Afternoon Section of the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Afternoon Section of the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks